

REMARKS

This amendment is filed on January 4, 2005, before the shortened statutory period for reply. Thus, applicants submit that no petitions for extension of time or other additional fees are required.

I. STATUS OF THE AMENDMENT

Claims 1-27 were pending prior to this amendment. By this amendment claims 1, 13, 14 and 19 have been amended, no claims have been canceled and no additional claims have been added. Thus, claims 1-27 remain pending and at issue.

II. RESPONSE TO THE PENDING OBJECTIONS AND REJECTIONS

A. OBJECTIONS TO THE DRAWINGS

As an initial matter, applicants have submitted six replacement sheets of the formal drawings that include the identifier "Replacement Sheet" in accordance with the requirements of 37 C.F.R. § 1.121.

FIG. 1 has been amended to address the objection set forth under 37 C.F.R. § 183(a). In particular, applicants have amended FIG. 1 to include a graphical representation of the easel recited by claims 10-12 and 26. In order to insure consistency between the specification and the drawings, applicants have amended specification paragraph [0006] to include the reference numeral "13".

FIGS 1 and 2 have been amended to include the reference numeral "33", and the appropriate lead line and arrow, to indicate the hole/opening in the lower portion of the flexible sheet 12. In order to insure consistency between the specification and the drawings, applicants have amended specification paragraph [0009] to include the reference numeral "33".

B. OBJECTIONS TO THE SPECIFICATION

The specification has been objected to as failing to include the heading "Summary of the Invention" and a summary. Applicants respectfully submit that a summary of the invention is not required under either 35 U.S.C. § 112 and 37 C.F.R. § 1.73. In particular, § 112 simply requires that:

"the specification shall contain a written description of the invention the section , and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." See 35 U.S.C. § 112.

Furthermore, Rule 1.73 requires only that a summary, "***when set forth***, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed." See 37 C.F.R. § 1.73, (emphasis added). Thus, it is clear that neither the law nor the rules requires inclusion of a summary in the specification. Rather, the laws and rules simply set forth the contents of a Summary *should the applicant choose to include one*. For these reasons, applicants respectfully submit that the application is order and requests withdrawal of the pending objection.

Applicants have amended paragraph [0006] to identify the easel mechanism with the reference numeral 13, as shown in amended FIG. 1. Paragraph [0009] has been amended to identify the mounting hole formed in the lower portion of the flexible sheet 12 with the reference numeral 33. Paragraph [0011] has been amended to correct an inadvertent typographical error. In particular, the reference numeral "36" on page 4, line 19, has been

amended to recite "38". By this amendment, the second ply 38 is clearly identified.

Applicants submit that these amendments are fully supported, and that no new matter has been added. Applicants respectfully request withdrawal of the objections to the specification.

C. OBJECTIONS TO THE CLAIMS

Claims 13-27 have been objected to as containing various informalities. Applicants respond to these objections by amending the claims 13 and 14 to recite, "first and second mounting holes" and "the rectangular substrate", respectively. Applicants submit that correction of these informalities does not constitute inclusion of new matter. Applicants respectfully request withdrawal of these claim objections.

D. REJECTIONS UNDER 35 U.S.C. §112

Claims 19-27 have been rejected under 35 U.S.C. §112, second paragraph as indefinite. In response, applicants respectfully requests that attention be directed to paragraph [0011] on page 4, line 22, to page 5, line 6. Briefly, this passage illustrates an exemplary embodiment of how the attachment tab 46 and the expanding attachment 54 cooperate with the second surface of the flexible substrate 12.

Based at least on this passage, applicants respectfully submit that claim 19, and all claims dependent directly or indirectly thereon, is definite and particularly points out the claimed subject matter. Accordingly, applicants respectfully request withdrawal of these claim rejections.

E. REJECTIONS UNDER 35 U.S.C. §102

Applicants respectfully traverse the rejection of claims 1, 2, 4, 8, 9, 19 and 21-25 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,085,534 (Eckstein).

Amended independent claim 1 recites, in relevant part, a file pocket positioned adjacent to a flexible substrate, the file pocket includes a first ply foldably connected to a second ply to form a closed interior. Similarly, amended independent claim 19 recites, in relevant part, attaching an expandable file pocket to a flexible substrate, the pocket having a first and second plies cooperating to define a closed interior. Thus, the file pocket includes a blank folded to define first and second plies of material and secured together to define a closed interior. See *generally* FIGS. 4 and 6, and paragraph [0004] on page 5, line 28 to page 6, line 7.

Eckstein does not disclose a file pocket including a first ply foldably connected to a second ply to form a closed interior. Eckstein simply discloses identical pieces of material 3 secured together to form a card holder 1. See col. 2, lines 24-30. In particular, each of the identical pieces of material 3 includes a slot and tongue arranged to cooperate with a corresponding slot and/or tongue in another piece of material 3 to form the data carrier holder. See col. 2, lines 38-41. Thus, the pieces of material of 3 disclosed in Eckstein are separate pieces and are not foldably connected first and second plies of the same piece of material, as recited by the claims at issue. Moreover, the pieces of material 3 do not, by themselves, form a closed interior, rather a pair of clamp bars 8 are required to form the slip-in compartments. See col. 2, lines 42-52. Because Eckstein fails to disclose each and every element

recited in the claims, Eckstein cannot anticipate claims 1, 2, 4, 8, 9, 19 and 21-25.

F. REJECTIONS UNDER 35 U.S.C. §103

Applicants respectfully traverse the rejection of claims 3, 6, 7, 10-18, 20, 26 and 27 under 35 U.S.C. § 103(a) as unpatentable over Eckstein in view of U.S. Patent No. 6,349,491 (Able) or U.S. Patent No. 4,226,039 (Young).

As discussed generally above in section E, amended independent claims 1, 13, and 19 recite, in relevant part, a file pocket including a first ply foldably connected to a second ply and arranged to form a closed interior. The file pocket engages a second surface of a flexible substrate using a first and second tab formed integrally to the first and second plies, respectively. Thus, the first and second plies of the file pocket are directly secured to the second surface of the flexible substrate using the integrally formed first and second tabs.

None of the cited references discloses a file pocket having first and second plies arranged to form a closed interior, much less one that is secured to the second surface of a flexible substrate using integrally formed first and second tabs. Eckstein simply discloses identical pieces of material 3 arranged to form a card holder 1 and secured together along fastening flap 6 using a pair of clamp bars 8. The fastening flap 6 simply engages the clamp bars 8, and does not fold in any way. Moreover, even if, for the sake of argument, the fastening flap 6 were a tab for securing the card holder, Eckstein does not disclose a flexible substrate or any other substrate to which the fastening flap could engage. Thus, even if the fastening flap 6 could be

folded, it would be a redundant component because there is no corresponding substrate or structure to which it can be secured.

Young does not supply all of the teaching lacking in Eckstein. In particular, Young does not disclose a file pocket secured to a second surface of a flexible substrate using an integrally formed first and second tab. Young discloses a plurality of V-shaped pocket panels 5 including end portions 29 secured using frame pieces 2 and 3. In particular, the frame pieces 2 and 3 have a panel-receiving portion 14 to engage and secure the end portions 29 of the V-shaped pocket panels 5. Similar to Eckstein, Young does not disclose that the end portions 29 can be folded, much less be folded to engage a flexible substrate.

Similarly, Able does not supply the teaching lacking in Eckstein. Able does not disclose a file pocket secured to a second surface of a flexible substrate using an integrally formed first and second tab. Rather, Able discloses a plurality of pockets welded to a base 12 and a header 16. The pockets are directly welded to the base 12 and do not include flaps or tabs of any kind.

Because no combination of Eckstein, Young and Able teaches or suggests all of the claim limitations set forth in the claims at issue, the pending action does not set forth a *prima facie* case of obviousness.¹ As

¹ To establish a *prima facie* case of obviousness, three basic criteria must be met:

- (a) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (b) Second, there must be a reasonable expectation of success.
- (c) Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

discussed above, Eckstein, Young and Able do not disclose or suggest securing a file pocket to a second surface of a flexible substrate using integrally formed tabs. Thus, any combination of Eckstein, Young and Able requires additional clamps to engage and secure the pieces of material and/or V-shaped pocket panels. Moreover, none of the references recognizes the benefit of securing the file pockets to the second surface of the flexible substrate using integrally formed tabs that allow the closed interior to expand and does not require additional hardware to secure the file pockets. For these reasons, amended independent claims 1, 13 and 19, and all claims depending directly or indirectly thereon, cannot be rendered obvious in light of any combination of Eckstein, Young and Able. Reconsideration and withdrawal of the obviousness rejection is hereby respectfully requested.

III. CONCLUSION

For these foregoing reasons, applicants submit the application is in condition for allowance. If there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855 (29618/38940). Reconsideration and withdrawal of the rejections are therefore respectfully requested.

Respectfully submitted for,

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APPENDIX

AMENDMENT TO THE DRAWINGS

Applicants filed the above-identified application on July 24, 2003 with six sheets of informal drawings that included FIGS. 1-8. Six sheets of formal drawings including FIGS. 1-8 were submitted on June 21, 2004. By this amendment, applicants submit six replacement sheets of formal drawings that include the identifier "Replacement Sheet" in accordance with the requirements of 37 C.F.R. §1.121. FIGS. 1 and 2 have been further amended. The newly submitted FIGS. 1 and 2 differ from those originally submitted on July 21, 2004 as follows:

FIG. 1 has been amended to comply with 37 C.F.R. §1.83(a) by showing easel 13, and appropriate lead line, recited in claims 10-12 and 26. It should be noted that specification paragraph [0006] has been amended to include the reference numeral "13". Support for these amendments to the drawings can be found at least in paragraph [0006] and the claims as originally filed.

FIGS. 1 and 2 have been amended to include the reference numeral "33", and the appropriate lead line and arrow, to indicate the hole/opening in the lower portion of the flexible sheet 12. It should be noted that specification paragraph [0009] has been amended to include the specific reference to the mounting hole 33. Support for these amendments to the drawings can be found at least in paragraph [0009] and the claims as originally filed.

Applicants respectfully request entry of these six replacement sheets of formal drawings and withdrawal of the pending objections.

Appendix: Six replacement sheets of drawings including amended
FIGS 1 and 2.